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APPEAL BRIEF - PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants: S.C. Cottrille et al. Attorney Docket No. MSFT117226

Application No: 09/339,634 Group Art Unit: 2176

Filed: June 24, 1999 Examiner: A.R. Yuan

Title: ASSOCIATING ANNOTATIONS WITH A CONTENT SOURCE

APPELLANTS' APPEAL BRIEF

Seattle, Washington  
April 18, 2005

TO THE COMMISSIONER FOR PATENTS:

This brief is in support of a Notice of Appeal filed January 21, 2005, to the Board of Patent Appeals and Interferences appealing the decision dated September 22, 2004, of the Examiner finally rejecting Claims 1-19.

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100



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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
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1420 Fifth Avenue  
Suite 2800  
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I. REAL PARTY IN INTEREST

The subject application is owned by Microsoft Corporation of Redmond, Washington.

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Suite 2800  
Seattle, Washington 98101  
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## II. RELATED APPEALS AND INTERFERENCES

Upon information and belief, Appellants do not have any knowledge of related appeals or interferences that may directly affect or have a bearing on the decision of the Board of Patent Appeals and Interferences (hereinafter "the Board") in the pending appeal.

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

### III. STATUS OF CLAIMS

On June 24, 1999, Appellants filed the pending patent application, including Claims 1-19. On October 31, 2002, Appellants filed an Amendment and Response in which Claims 1, 7, 10, and 16 were amended. On April 10, 2003, Appellants filed an Amendment and Response in which Claims 1, 5, 7, and 16 were amended. On September 15, 2003, an Amendment and Response was filed in which Claims 1, 7, and 10-16 were amended. On September 29, 2003, a Request for Continued Examination was filed in order to have the Examiner consider the Amendment filed on September 15, 2003. The claims, as amended and set forth in the Amendment filed September 15, 2003, considered by the Examiner are the current claims of the present application.

This Appeal follows in which the Appellants entreat the Board to reverse the final rejection of Claims 1-19. The claims on appeal are set forth in the Appendix.

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1420 Fifth Avenue  
Suite 2800  
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206.682.8100

IV. STATUS OF AMENDMENTS

No amendment has been filed subsequent to the final rejection dated September 22, 2004.

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

## V. SUMMARY OF CLAIMED SUBJECT MATTER

Appellants set forth a brief discussion of the exemplary embodiments of the present invention, to help the Board better appreciate Appellant's invention. The following discussion of the disclosed embodiments of the Appellant's invention are not provided to define the scope or interpretation of any of the appealed claims.

### A. Exemplary Embodiments

An exemplary embodiment of the present invention relates to annotations. An annotation is defined as any object that is associated with another object by some relationship. The annotation object may be of any type and the relationship between the annotation object and the object that it annotates may also be of any type. An exemplary embodiment of the present invention provides a superior manner by which annotations may be stored and accounted for.

According to one exemplary embodiment of the present invention, a Tier I server is employed to store one or more annotations associated with a document identifier. The Tier I server handles a large number of requests from clients, and responds to requests as fast as possible. The Tier I server is also specifically designed to determine if annotations are associated with a document and, if so, will retrieve an index of the annotations associated with the document from a Tier II server.

In one exemplary embodiment, the Tier II server contains indices for the contents of all annotations. The Tier II server may also store annotation properties. Generally, the information stored on the Tier II server is considered additional information to the annotation information stored on the Tier I server.

Once the index of the annotation is retrieved from the Tier II server, a reference to a Tier III server may be made. The Tier III server is the storage device that actually stores the

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
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annotation objects--documents, for example. The end result is that an identified annotation object may be retrieved by a client based on initial referencing of the Tier I and Tier II servers.

The above-described exemplary embodiments of the present invention provide a plurality of servers that function to provide quick reference to annotations. Speed of reference is achieved as a result of each upper tier of the tiered system having information in addition to the information in a tier below it. This, for example, allows a Tier I server to store less annotation information than a Tier II server.

B. Explanation of Various Subject Matter Defined in the Claims

Regarding the claims, independent Claim 1 is directed to a scalable method of storing an annotation associated with a content source. See the instant specification at pages 12-14 and Figures 3-5. According to independent Claim 1, the method includes representing an annotation as an object having a plurality of properties, where one of the plurality of properties is a document identifier. The document identifier identifies the content source with which the annotation is associated. The method further includes storing the annotation and the information about the annotation accessible using the document identifier on the servers of a multiple tier hierarchical annotation server system. In particular, the information about the annotation, but not the annotation, is stored on a lower tier server and the annotation is stored on a higher tier server.

Claims 2-6 are directly or indirectly dependent upon independent Claim 1. These dependent claims further define the method set forth in independent Claim 1. Dependent Claim 2 is dependent upon Claim 1 and recites that the act of representing the annotation as an object having a plurality of properties includes defining generic properties of the annotation. Claim 3 is dependent upon dependent Claim 2 and recites that the generic properties are selected from a group that includes type, content, author name, creation time, modify time, time-to-live, document identifier, index, and parent identifier. Claim 4 is dependent upon Claim 3 and recites

that the type of property the annotation is selected from the group that includes a text file, a threaded message, an audio file, a video file, a calendar file, and a chat. Claim 5 is dependent upon dependent Claim 2 and recites the act of requesting the annotation as an object having a plurality of properties includes defining one or more types of specific properties unique to the annotation. Claim 6 is dependent upon independent Claim 1 and recites that the document identifier selected from the group that includes a file name, a directory path, and a uniform resource locator.

Independent Claim 7 is directed to a scalable method of retrieving an annotation associated with a content source. See the instant specification at pages 12-14 and Figures 3-5. The method of independent Claim 7 includes sending a document identifier associated with the content source to a Tier I server, where the Tier I server is part of a multiple tier hierarchical annotation server system that also includes a Tier II server. The Tier I server is capable of storing minimal information regarding annotations associated with the content source, where the minimal information includes the existence of annotations associated with the content source and the identification of the Tier II server if the annotations exist. If an annotation is associated with the document identifier, the method retrieves a reference from the Tier I server to the Tier II server, where the Tier II server maintains additional information regarding the annotation associated with the document identifier.

Claims 8-15 depend directly or indirectly from independent Claim 7 and are directed to further limitations of the method of independent Claim 7. Claim 8 is dependent on Claim 7 and recites displaying the first response in a manner that is non-intrusive to the content source. Claim 9 is dependent from Claim 7 and recites displaying the first response in a manner that is intrusive to the content source. Claim 10 is dependent from Claim 7 and recites that the multiple tier hierarchical annotation server system also includes a Tier III server. According to dependent

Claim 10, the method of independent Claim 7 further includes sending a request to the Tier II server for the additional information regarding the annotation associated with the content source. Furthermore, the method includes receiving a response from the Tier II server, where the response includes a reference to the Tier III server. In this case, the Tier III server stores the annotation associated with the document identifier. Claim 11 is dependent upon Claim 10 and recites that the response from the Tier II server also includes at least one property of the annotation. Claim 11 further sets forth that the method further includes displaying at least one property of the annotation in a manner that is non-intrusive to the content source. Claim 12 is dependent on Claim 10 and recites that the response from the Tier II server also includes at least one property of the annotation. Claim 12 further recites that the method includes displaying at least one property of the annotation in a manner that is intrusive to the content source. Claim 13 is dependent upon Claim 10 and recites sending to the Tier III server an annotation identifier that identifies the annotation associated with the content source, and receiving a third response from the Tier III server, where the third response includes the annotation identified by the annotation identifier. Claim 14 is dependent upon Claim 13 and recites displaying the annotation identified by the annotation identifier in a manner that is non-intrusive to the content source. Claim 15 is dependent upon Claim 13 and recites displaying the annotation identified by the annotation identifier in a manner that is intrusive to the content source.

Independent Claim 16 is directed to a computer readable medium that includes computer executable steps for executing a scalable method for storing an annotation associated with a content source. See the instant specification at pages 12-14 as well as Figures 3-5. Independent Claim 16 includes the steps of representing an annotation as an object having a plurality of properties where one of the plurality of properties is a document identifier. According to the claim, the document identifier identifies the content source with which the annotation is

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
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associated. Independent Claim 16 further includes storing the annotation and information about the annotation accessible using the document identifier on the servers of a multiple tier hierarchical annotation server system. The information about the annotation but not the annotation is stored on a lower tier server, and the annotation is stored on a higher tier server.

Claims 17-19 are indirectly or directly dependent from independent Claim 16 and further limit the method set forth in independent Claim 16. Dependent Claim 17 depends upon independent Claim 16 and recites that the plurality of properties are selected from a group that includes type, content, author name, creation time, modify time, time-to-live, document identifier, index, and parent identifier. Claim 18 depends upon dependent Claim 17 and recites that the type property of the annotation is selected from the group that includes a text file, a threaded message, an audio file, a video file, a calendar file, and a chat. Claim 19 depends from dependent Claim 17 and recites the document identifier property of the annotation is selected from the group that includes a file name, a directory path, and a uniform resource locator.

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

**VI. GROUNDΣ OF REJECTION TO BE REVIEWED ON APPEAL**

Independent Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over van Hoff, U.S. Patent No. 5,822,539, in view of Publication "Scope of Annotation Protocol" (hereinafter "the Annotation Publication"). In addition, Claims 1-6 and 18-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over van Hoff in view of Van Der Meer, U.S. Patent No. 6,289,362 B1, and further in view of the publication Annotation Protocol.

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
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## VII. ARGUMENT

As discussed below, the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner bears the burden of establishing a *prima facie* case of obviousness . . . only if this burden is met does the burden of coming forward with rebuttal arguments or evidence shift to the applicant . . . when the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned. *In re Deuel*, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). One of the elements for establishing a proper *prima facie* case of obvious is the use of one or more references that teach the invention under examination. As the Board will glean from the following discussion, the Examiner has failed to establish a *prima facie* case of obviousness, as the combination of references fail to teach or suggest the claims of the instant application.

Here, the applied and cited references fail to teach or suggest, among other features, the feature of "receiving a reference from said tier I server to said tier II server, said tier II server maintaining additional information regarding the annotation associated with the document identifier," as set forth in independent Claim 7. The applied and cited references also fail to teach or suggest "the information about the annotation but not the annotation is stored on a lower tier server and the annotation is stored on a higher tier server," as set forth in independent Claim 1. Moreover, the applied and cited references fail to teach or suggest "the information about the annotation but not the annotation is stored on a lower tier server, and the annotation is stored on a higher tier server," as is set forth in independent Claim 16. For a better appreciation of the arguments below, Appellant summarizes the applied references.

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

**A      Summary of the van Hoff Reference**

Van Hoff provides a client-side system and method for inserting hypertext links (hyperlinks) to annotations into documents. Each document is viewable on a client computer having a browser configured to request and receive documents over a network.

The hyperlinks of the van Hoff reference are inserted into a document by any annotation proxy, which in van Hoff is a software procedure on a single computer (either a client or a separate computer) configured to insert hypertext links to annotations in a document. The criteria for identifying where hyperlinks to annotations should be added to a document includes the process of matching a group of characters in the document to a group of character strings in one or more dictionaries of cross-references. The hyperlinks are added to the document regardless of any document identifier. Neither the hyperlink, nor the annotation associated with the hyperlink, includes a document identifier, i.e., an identifier that identifies the document into which the hyperlink is inserted. The annotation proxy then relates the annotated document to the browser, which ultimately displays the merged document.

In one embodiment of the van Hoff reference, a web client computer 102 and a web information server 104 are disclosed that have interposed therebetween an annotation proxy server 118. (See Col. 4, lines 60-62, of the van Hoff reference.) The annotation proxy server 118 includes one or more annotation directories 191 and 192. Each annotation directory is uniquely identifiable, such as by name or number, so that a user associated with the client computer 102 may select the desired annotation directory from among several that may be present on the proxy server 118. (See Col. 5, lines 20-32, of the van Hoff reference.)

When the client computer 102 requests a document, a user associated with the client computer 102 also specifies the annotation proxy server 118, and one of the annotation directories 191 and 192 provided on that server. (See Col. 5, lines 58-61, of the van Hoff

reference.) Using the annotation information stored on one of the directories 191 and 192, the proxy server 118 transmits a request to the server 104 for a document using a unique document identifier associated with an annotation stored in one of the directories 191 and 192. (See Col. 6, lines 41-43, of the van Hoff reference.)

Nowhere does van Hoff teach multi-tier servers of the type contemplated by the present invention. All annotations are stored on a client or similar device, not on multi-tier servers where lower order tiers include document identifiers but not annotations or more information about annotations.

B. Summary of the Van Der Meer Reference

The Van Der Meer reference teaches a system and method for presenting an ordered set of network object links to documents. The network object links are called annotated universal addresses ("AUAs"). The AUAs are presented by a browser, much like a list of bookmarks. The AUAs are maintained in an AUA database. The contents of the AUA database are presented to a user within a presentation context. Van Der Meer purportedly allows the user to select a different presentation context without affecting the contents of the AUA database. One type of presentation context is organized like a diary or agenda.

Van Der Meer uses the word "annotation" to describe the configuration data that describes the properties of an AUA, such as expiration date, re-exportation data, link data, suggested section in which to store an AUA, natural size of the object, description of the object, privacy level, type of object, etc. (See Col. 6 and Col. 7 of the Van Der Meer reference.) These properties (configuration data) are not the same as the document annotations of either van Hoff or the present invention.

Annotation, as used in both van Hoff and the present invention, describes information that adds to the understanding of a related content source, e.g., a document. Annotation does not

describe or relate to configuration data type properties of a content source, e.g., a document. While van Hoff does employ hyperlinks to annotations and the present invention does store information about annotations (which could employ configuration data), annotations is used in an entirely different sense than in Van Der Meer.

The system of Van Der Meer includes an AUA database server, a presentation context server, an owner system, and content providers. Each content provider includes descriptions of presentable objects and AUAs that identify the location of the objects. The content providers also include "annotations" for controlling aspects of the objects. The AUA database and the presentation content server maintain the AUAs in a per-user AUA database. The AUA database allows an owner to access the AUAs for presentation. Since the content providers include the AUA annotations, the content providers have control over certain aspects of the objects as they are presented to the owner and any other user.

Nowhere does the Van Der Meer reference teach or suggest the Appellant's claimed invention. Van Der Meer provides a way of presenting network object links. The network object links or AUAs of the Van Der Meer reference are objects with configuration data that describe features of the objects, called "annotations." The annotations of Van Der Meer are not objects--rather, they are configuration data that describe properties of the network object links (see Figure 3 and Cols. 6 and 7 of the Van Der Meer reference). Once again, the annotations associated with Van Der Meer AUAs are not annotation objects. Rather, Van Der Meer's annotations are configuration data that "indicate how to handle some aspect of the object information 132 or the universal address 306." (Col. 6, lines, 59-60.)

#### C. Summary of the Publication Annotation Protocol

The publication annotation protocol teaches an annotation server that may store annotations for several distinct sets of URLs. The publication teaches that an annotation set may

contain several annotation subsets that may be contained by several annotation supersets. Subsets and supersets may be on different servers. The publication further indicates that everything about a single set should probably be on a single server. (See page 2, first paragraph of the publication.) The publication annotation protocol further teaches that annotation servers should be able to offer information to clients about all of the URLs that have annotations or may have annotations so that clients may avoid making requests of a server that has no annotations in the set. This may be given in terms of a pattern of lists of alternative patterns to abbreviate the transference speed the look-up. The relied upon publication indicates that this should facilitate scalable look-up of annotations by clients and servers.

D. The Rejection of Independent Claim 7 under 35 U.S.C. § 103(a) over USPN 5,822,539 in view of the Annotation Publication

The combination of references relied upon by the Examiner fail to teach or suggest, among many other limitations, the claimed limitation of "receiving a reference from said tier I server to said tier II server, said tier II server maintaining additional information regarding the annotation associated with the document identifier." The Appellant's reasoning is discussed in the following.

As discussed heretofore, van Hoff teaches a web client computer 102 and a web information server 104. Interposed between the web client 102 and the web information server 104 is an annotation proxy server 118. (See Col. 4, lines 60-62 of the van Hoff patent document.) The annotation proxy server 118 includes one or more annotation directories 191 and 192. Each annotation directory is uniquely identifiable, such as by name or number, so that a user associated with the client computer 102 may select the desired annotation directory from among several that may be present on the proxy server 118. (See Col. 5, lines 28-32, of the relied upon van Hoff patent.)

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
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When the client computer 102 requests a document, a user associated with the client computer 102 also specifies the annotation proxy server 118, and one of the annotation directories 191 and 192 provided on that server. (See Col. 5, lines 58-61, of the relied upon patent document.)

Using annotation information stored in one of the directories 191 and 192, the proxy server 118 transmits a request to the server 104 for a document using a unique document identifier associated with an annotation stored in one of the directories 191 and 192. (See Col. 6, lines 41-43, of the van Hoff patent document.)

As is understood from the above discussion, nothing in the van Hoff patent teaches receiving from a Tier I server a reference to said Tier II server, "said tier II server maintaining additional information regarding the annotation associated with the document identifier." Instead, van Hoff teaches that all annotation information is specifically stored on the annotation proxy server 118.

The rejection of independent Claim 7 asserts, on page 3 of the current Office Action, that van Hoff teaches "receiving a reference from a said tier I server to said tier II server, said tier II server maintaining additional information regarding the annotation associated with the document identifier." However, from a reading of van Hoff, as summarized above, it is clear that the so-called Tier II server, which the Office Action associates with the web information server 104, does not contain annotation information. Instead, the web information server 104 only includes documents associated with annotations stored on the annotation proxy server 118. As a result, Appellants submit that the Office Action's position regarding what is taught by van Hoff is incorrect.

Although the above discussion of the rejection of independent Claim 7 is sufficient to find that the rejection of the claim is improper (failure to present a *prima facie* case of

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
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obviousness), Appellants further assert that the rejection of independent Claim 7 is deficient for other reasons.

The current Office Action recognizes, on page 4, that van Hoff does not disclose a "tier I server storing minimal information regarding annotations associated with said content source, said minimum information including the existence of annotations associated with said content source and the identification of said tier I server if said annotation exist[s]." The Office Action relies on the publication annotation protocol to make up for the deficiencies of the van Hoff disclosure. Appellants disagree that the Examiner's reliance upon the publication annotation protocol rectifies the deficiency of the van Hoff patent document that has been admitted by the Examiner. In particular, as discussed below, the disclosure of the publication annotation protocol does not make up for the deficiencies of van Hoff.

As previously discussed, the publication annotation protocol teaches an annotation server that may store annotations for several distinct sets of URLs. The publication teaches that an annotation set may contain several annotation subsets that may be contained by several annotation supersets. Subsets and supersets may be on different servers. The publication further indicates that everything about a single set should probably be on a single server. (See page 2, first paragraph of the publication.) The publication annotation protocol further teaches that annotation servers should be able to offer information to clients about all of the URLs that have annotations or may have annotations so that clients may avoid making requests of a server that has no annotations in the set. This may be given in terms of a pattern of lists of alternative patterns to abbreviate the transfer and therefore speed the look-up. The relied upon publication indicates that this should facilitate scaleable look-up of annotations by clients and servers.

The Examiner has misunderstood the context of the publication that associated with the scaleable functionality indicated therein. As just a reminder, in order to make up for the

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

deficiencies associated with the van Hoff patent document, discussed above, the publication annotation protocol must teach a "tier II server maintaining additional information regarding the annotation associated with the document identifier." Such a tier II server, with additional information, is simply not taught by the publication annotation protocol.

The subsets and supersets referred to in the publication annotation protocol do not refer to the practice of storing annotation information on a first server, and additional annotation information that is stored on a second server, where the annotation information stored on the second server has associations with annotation information stored on a first server. Instead, the subsets and supersets merely relate to the practice of assigning a certain level of security or other related property to the respective subsets and supersets. In particular, a given subset and/or superset may inherit properties and/or security properties from another subset or superset. This does not relate to the practice of having annotation information on a Tier I server and further information associated with annotation information stored on the Tier I server, which is stored on a Tier II server.

The scaleable functionality discussed in the publication annotation protocol relates to the use of annotation servers that are capable of identifying URLs that may or may not have associated annotations. The scalability functionality does not refer to a system or practice where a Tier I server includes annotation information and a Tier II server that includes further annotation information related to the annotation information stored on the Tier I server.

In summary, Appellants submit that the two documents relied upon in combination together to reject independent Claim 7, taken alone or in combination, fail to teach or suggest at least the indicated limitations of independent Claim 7. Accordingly, Appellants respectfully submit that the Examiner has failed to show the required *prima facie* case of obviousness.

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

E. The Rejection of Claims 1-6 and 8-19 under 35 U.S.C. § 103(a) over USPN 5,822,539 and the Annotation Publication, and further in view of USPN 6,289,362 B1

1. Independent Claims 1 and 16

The rejection of both independent Claims 1 and 16 includes the combination of van Hoff, Van Der Meer, and the publication annotation protocol. Independent Claim 1 sets forth a combination of limitations including "information about the annotation but not the annotation is stored on a lower tier server and the annotation as stored on a higher tier server." Independent Claim 16 sets forth substantially identical subject matter. Therefore, the following discussion as to why independent Claim 1 is patentable over the relied upon references is also applicable to independent Claim 16.

The current Office Action asserts that van Hoff teaches "storing the annotation on the servers of a multi-tier hierarchical annotation server system wherein the information about the annotation but not the annotation is stored on a lower tier server and the annotation is stored on a higher tier server." (See page 5 of the current Office Action.) The teachings of van Hoff are described in detail above. Appellants reiterate that van Hoff simply does not teach a system that includes a server that has an annotation reference, and a subsequent server that includes further information that is related to annotation information on the first server.

As was previously discussed, the annotation proxy server 118 includes annotation directories 191 and 192. The web server 104, in contrast, includes data, such as documents, that may be forwarded to the annotation proxy server 118 for annotating. Van Hoff explicitly states that the annotation proxy server 118 "performs document parsing and annotation." (See Col. 4, lines 39-41, of the van Hoff patent document.) Van Hoff is accordingly limited to a system that includes annotations on one server and data, more specifically documents, on another server.

The patent to Van Der Meer was relied upon in the current Office Action to teach "an object including annotation," and the publication annotation protocol was relied upon to teach "storing the annotation information about the annotation accessible using the document identifier." (See page 6 of the current Office Action.) Even assuming *arguendo* that the Van Der Meer patent document and the publication annotation protocol teach that which they are asserted to teach, these teachings do not make up for the deficiencies of van Hoff. Accordingly, whether taken in combination or alone, the documents relied upon in the Office Action to reject independent Claims 1 and 16 fail to make up a proper *prima facie* case of obviousness that may be used to reject the independent claims.

## 2. Dependent Claim 5

Appellants further submit that dependent Claims 2-6 and 17-19 are allowable for reasons in addition to the reasons why independent Claims 1 and 16 are allowable. For example, Appellants have been unable to find where any of the cited and applied references discusses or even remotely suggests "defining one or more type specific properties unique to the annotation," as recited in Claim 5. None of the relied upon references teaches, discloses or suggests type specific properties, let alone type specific properties unique to an annotation. The suggestion in the current Office Action that an annotation identifier is a "type identifier" is submitted to be incorrect. As is pointed out in the application specification (page 11, lines 3-4), property types identify the type of annotation. Because none of the relied upon references teaches or suggests type specific properties, Appellants submit that these references taken either alone or in combination would not have rendered the subject matter of Claim 5 obvious to persons of ordinary skill in the art at the time the mention was made. Thus, Claim 5 is submitted to be allowable for this reason as well.

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
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### 3. Dependent Claim 10

Claims 8-15 depend from allowable Claim 7 and are therefore allowable for the same reasons that Claim 7 is allowable. Claims 8-15 are also allowable for additional reasons. Many of these claims include further recitation not taught, disclosed, or even suggested by any of the references, alone or in combination. For example, Claim 10 recites a tier III server. More specifically, Claim 10 includes a recitation "receiving a response from the tier II server, said response including a reference to said tier III server, said tier III server storing the annotation associated with the document identifier." The current Office Action is correct in noting that van Hoff has no Tier III server. However, the assertion that the presentation context server of Van Der Meer is a Tier III server is submitted to be incorrect. Van Der Meer's presentation context server has no annotations. Van Hoff's annotations are all associated with an annotation proxy server. Appellants submit that one of ordinary skill in the art would not have been motivated to combine the presentation context server (having no annotation) with the annotation proxy of van Hoff to form a Tier III server. Such a combination would not enhance the ability of either the presentation server to present context or the annotation proxy to annotate. Accordingly, it is clear that the Tier III server recited in Claim 10 is not taught or even remotely suggested by any of the references relied upon by the Examiner, alone or in combination. Thus, Appellants submit that Claim 10 and all the claims dependant therefrom are allowable for reasons in addition to the reasons why Claim 7, the claim from which Claim 10 depends, is allowable.

### 4. Dependent Claim 13

Claim 13, which depends from Claim 10, adds further recitation not taught or suggested by any of the references relied upon by the Examiner. More specifically, Claim 13 recites details of the functional operation of a Tier III server not taught or suggested by the cited and relied

upon references. In particular, there is no teaching or suggestion of sending to a Tier III server an annotation identifier that identifies an "annotation associated with the content source" in any of the cited and applied references. Van Hoff stores all of its annotations on a client device (or a separate annotation proxy server device). Thus, there is no need and, thus, no motivation in van Hoff to send an annotation identifier anywhere, let alone to a Tier III server. Nor does Van Der Meer teach or suggest this subject matter. Similarly, the publication annotation protocol does not teach or suggest this subject matter. Further, none of the references teaches or suggests "receiving a third response from the tier III server, wherein the third response comprises a body for the annotation identified by the annotation identifier," particularly when this subject matter is considered in combination with the other recitations of Claim 13 and the recitations of the claim which Claim 13 depends. Accordingly, Appellants submit that Claim 13 (and its dependent Claims 14-15) are allowable for reasons in addition to the reasons why the claims from which Claim 13 depends are allowable.

In light of the foregoing remarks, it is clear that none of the applied and cited references teaches, let alone renders unpatentable, the claimed invention recited in the claims. Therefore, Appellant submits that all of the claims in the present application are patentably distinguishable over the teachings of the cited references. Therefore, it is submitted that the rejections of the claims are erroneous, and reversal of the rejections is respectfully requested by the Board.

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

## VIII. CLAIMS APPENDIX

The most current condition or form of the claims can be found in the amendment sent to the Examiner on September 15, 2003. This was faxed to the Office.

1. A scalable method of storing an annotation associated with a content source, the method comprising:

representing an annotation as an object having a plurality of properties wherein one of the plurality of properties is a document identifier, the document identifier identifying the content source with which the annotation is associated; and

storing the annotation and information about the annotation accessible using the document identifier on the servers of a multiple tier hierarchical annotation server system wherein the information about the annotation but not the annotation is stored on a lower tier server and the annotation is stored on a higher tier server.

2. The method of claim 1, wherein the act of representing the annotation as an object having a plurality of properties further comprises defining generic properties of the annotation.

3. The method of claim 2, wherein the generic properties are selected from the group consisting of: type, content, author name, creation time, modify time, time-to-live, document identifier, index and parent identifier.

4. The method of claim 3, wherein the type property of the annotation is selected from the group consisting of: a text file, a threaded message, an audio file, a video file, a calendar file, and a chat.

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

5. The method of claim 2, wherein the act of representing the annotation as a object having a plurality of properties further comprises defining one or more type specific properties unique to the annotation.

6. The method of claim 1, wherein the document identifier is selected from the group consisting of: a file name, a directory path, and a uniform resource locator.

7. A scalable method of retrieving an annotation associated with a content source, the method comprising:

sending a document identifier associated with a content source to a tier I server, said tier I server being part of a multiple tier hierarchical annotation server system that also includes a tier II server, said tier I server storing minimal information regarding annotations associated with said content source, said minimal information including the existence of annotations associated with said content source and the identification of said tier II server if said annotations exist; and

if an annotation is associated with the document identifier, receiving a reference from said tier I server to said tier II server, said tier II server maintaining additional information regarding the annotation associated with the document identifier.

8. The method of claim 7, further comprising displaying the first response in a manner that is non-intrusive to the content source.

9. The method of claim 7, further comprising displaying the first response in a manner that is intrusive to the content source.

10. The method of Claim 7, wherein said multiple tier hierarchical annotation server system also includes a tier III server and further comprising:

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
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sending a request to the tier II server for said additional information regarding the annotation associated with the content source; and

receiving a response from the tier II server, said response including a reference to said tier III server, said tier III server storing the annotation associated with the document identifier.

11. The method of claim 10 wherein said response from said tier II server also includes at least one property of the annotation, further comprising displaying the at least one property of the annotation in a manner that is non-intrusive to the content source.

12. The method of claim 10 wherein said response from said tier II server also includes at least one property of the annotation, further comprising displaying the at least one property of the annotation in a manner that is intrusive to the content source.

13. The method of claim 10, further comprising:

sending to the tier III server an annotation identifier that identifies the annotation associated with the content source; and

receiving a third response from the tier III server, wherein the third response comprises the annotation identified by the annotation identifier.

14. The method of claim 13, further comprising displaying the annotation identified by the annotation identifier in a manner that is non-intrusive to the content source.

15. The method of claim 13, further comprising displaying the annotation identified by the annotation identifier in a manner that is intrusive to the content source.

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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
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16. A computer readable medium comprising computer executable steps for executing a scalable method for storing an annotation associated with a content source, the method comprising:

representing an annotation as an object having a plurality of properties wherein one of the plurality of properties is a document identifier, said document identifier identifying the content source with which the annotation is associated; and

storing said annotation and information about the annotation accessible using the document identifier on the servers of a multiple tier hierarchical annotation server system wherein the information about the annotation but not the annotation is stored on a lower tier server, and the annotation is stored on a higher tier server.

17. The computer readable medium of claim 16, wherein the plurality of properties are selected from the group consisting of: type, content, author name, creation time, modify time, time-to-live, document identifier, index, and parent identifier.

18. The computer readable medium of claim 17, wherein the type property of the annotation is selected from the group consisting of: a text file, a threaded message, an audio file, a video file, a calendar file, and a chat.

19. The computer readable medium of claim 17, wherein the document identifier property of the annotation is selected from the group consisting of: a file name, a directory path, and a uniform resource locator.

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

## IX. EVIDENCE APPENDIX

None.

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

X. RELATED PROCEEDINGS APPENDIX

None.

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

Respectfully submitted,

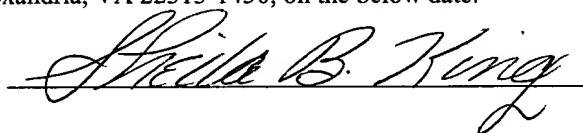
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JOHNSON KINDNESS<sup>PLLC</sup>



Timothy R. Wyckoff  
Registered Patent Agent  
Registration No. 46,175  
Direct Dial No. 206.695.1641

I hereby certify that this correspondence is being deposited in triplicate with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: April 18, 2005



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1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
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